

REMARKS

Claims 1, 2, 4-6, 8, 11, 14-18 and 20-26 are now presented for examination.

Claims 1, 11 and 25 are independent.

In the Office Action, Claim 1 was rejected under "the judicially created doctrine of double patenting" in view of Claims 1 and 5 of U.S. Patent 6,530,638 (Shibata et al.). In addition, Claim 11 was rejected over Claims 15 and 19 of *Shibata*, and Claim 25, over Claims 25 and 19 of *Shibata*, and Claims 4-6 and 14-18 were rejected for obviousness-type double patenting over Claims 6-8 and 19-24 of *Shibata*.

The Office Action Is Incomplete

Initially, Applicants note that Claims 2, 8, 20-25 and 26 were not acted on. Accordingly, Applicants assume that the Examiner considers these claims allowable. If that is not correct, of course, the next Office Action, if not an allowance, must be non-final.

The Rejection is Unclear

The rejection of Claim 1 is said to be based on Claims 1 and 5 of *Shibata*. Claim 5 depends from Claim 2, which in turn depends from Claim 1. Applicants assume that it was not intended to reject Claim 1 based on each of Claims 1 and 5 separately, since in that case the rejection would presumably have been worded differently. Similarly, if the intention had been to based the rejection on the scope of dependent Claim 5, there would have been no reason to mention Claim 1.

Applicants can only surmise that the intention was instead to based the rejection on the basis of the recitations of *Shibata* Claim 1 plus the recitations set out expressly in *Shibata* Claim 5, without the recitations of Claim 2 (this will be referred to hereinafter as "Claim 1 + 5 - 2", for want of a better label). If that was indeed the intent,

then it is submitted that the rejection is entirely improper. An obviousness-type double-patenting rejection is based on the idea that an application claim, although not identical in scope to any claim of the patent, defines a scope of protection that is nonetheless merely an obvious variant of what is claimed by *some one claim* of the patent. The MPEP states:

“In determining whether a nonstatutory basis exists for a double patenting rejection, the first question to be asked is - does any claim in the application define an invention that is anticipated by, or is merely an obvious variation of, an invention claimed in the patent? [emphasis added]” MPEP § 804.

That is, the basis of the rejection must be something that is claimed in the reference, not just something that possibly could have been claimed. Thus, a rejection could be based on Claim 1, if an application claim were deemed to define subject matter that is only an obvious variant of what is defined in *Shibata* Claim 1, or on Claim 2/1, if an obvious variant of the subject matter of Claim 2 including all the recitations of its based claim, or on Claim 5/2/1, if an obvious variant of the recitations of Claim 5 including all those of its parent Claims 2 and 1.

If Applicants have correctly understood the intention of the Office Action, then “Claim 1 + 5 - 2” on which this rejection is based, is fictitious, in that there is not actually any claim in *Shibata* that has the exact set of recitations on which the rejection purports to be based.

Similarly, the rejection of Claim 11 purports to be over Claims 15 and 19, which both depend directly from Claim 14. Again, such picking and choosing from the recitations of plural claims to create a fictitious claim on which to be an obviousness-type double-patenting rejection, is believed to be improper. The same is equally true (if not

even more so) of the rejection of Claim 25, which is based on patent independent Claim 25 and patent Claim 19 which is dependent from a *different* base claim (Claim 14).

There are additional respects in which the rejections as set out in the Office Action are unclear, and as best understood appear to be legally improper. Applicants do not believe it is necessary to set out each such flaw at present, but wish to make clear that they do not by any means imply or concede that the points discussed above are the only ways in which the double-patenting rejections are improper.

The Rejected Claims Are Allowable Over the Shibata Claims

Even putting aside what Applicants believe are fatal flaws in the rejections set out in the Office Action, Applicants believe that their claims are allowable over *Shibata*. With regard to Claim 1, Applicants respectfully note that that claim, as amended in the Amendment dated May 24, 2006, reads as follows:

“1. An image processing method of generating print data for a plurality of different color materials to be used by a printer, the method comprising:

a step of generating print data of *blue* by using print data of *cyan and magenta* from among the plurality of colors of print data; and

a step of generating processed print data, in which original print data of *cyan and magenta* are replaced at least partially with the print data of *blue*,

wherein the color material for generating the print data of *blue* has a higher lightness than do the color materials for generating the print data of *cyan and magenta*. [emphases added]”

Shibata shows generating first data of a secondary color for predetermined two color materials. *Shibata*, however, does not claim any of the recitations of Claim 1 that are italicized above. Claim 1, moreover, does not recite “predetermined two color

materials”, but rather, “cyan and magenta”. Among yellow, cyan and magenta, only cyan and magenta are replaced by blue. This is technically significant because blue is the secondary color of cyan and magenta, and because yellow has a high lightness and its granularity is not aggravated as severely as is that of cyan and magenta. See the specification at page 18, line 16, to page 19, line 8. This recited replacement of cyan and magenta by blue provides an efficient reduction of the granularity.

In addition, as recited in the wherein clause of Claim 1, the print lightness with blue is made higher than that with cyan and magenta, which further reduces the granularity. See the specification at page 19, lines 8-19.

The Office Action argues that from knowledge of undercolor removal (“UCR”) techniques, it would have been obvious to one of ordinary skill to remove other predetermined combinations of signals from image data. This argument is traversed. UCR has as its object to get better print quality by using black ink as well as ink of three (subtractive) primary colors, and calculates the amount of black ink to be used on the basis of $\min\{Y,C,M\}$. It is not at all seen how this knowledge would have given a person of merely ordinary skill any guidance in trying to deal with granularity problems (such as are addressed by the present invention), much less how it would have led such person to consider subtracting colorant based just on two color components rather than on three, as in UCR. (If the Examiner disagrees, he is respectfully requested to cite prior art to support his view.)

For all these reasons, it is believed to be clear that, in view of the underlined recitations, Claim 1 is not a mere obvious variant of what is claimed in *Shibata*.

The other independent claims are believed to be allowable over the *Shibata* claims for reasons analogous to those discussed above in connection with Claim 1. The other claims in this application are each dependent from one or another of the independent claims discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicants respectfully request favorable reconsideration and early passage to issue of the present application.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

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